

REMARKS

Favorable reconsideration of the application, in light of the preceding amendments and following discussion, is respectfully requested.

Claims 1-55 are pending in the present application. Claim 44 is amended, and no claims are canceled. Claims 4, 7-15, 19-43, and 47-55 were withdrawn from consideration.¹

Claim Rejections under 35 U.S.C. § 112

Claims 44-46 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite. In response to this rejection, independent claim 44 is amended to clarify where the oxidation preventing layer, second insulating layer, dielectric layer, and plate electrode are formed.

More specifically, amended claim 44 recites, *inter alia*, the following:

- forming an oxidation preventing layer at least on one of the plurality of bit lines;
- forming a second insulating layer at least on the one of the plurality of bit lines;
- forming a contact hole exposing a portion of the semiconductor substrate;
- forming a storage electrode connected to the portion of the semiconductor substrate through the contact hole;
- forming a dielectric layer on the storage electrode; and
- forming a plate electrode on the dielectric layer.

Therefore, Applicants respectfully request that the rejection of claim 44 and claims 45-46 depending therefrom under 35 U.S.C. §112, second paragraph be withdrawn.

¹ Office Action mailed April 13, 2005, page 2, paragraph 2; Office Action Summary 4a).

Claim Rejections under 35 U.S.C. § 102 and § 103

Claims 1-3, 5, 17, 18, and 44-46 stand rejected under 35 U.S.C. § 102(e) as anticipated by Tsai (U.S. Patent No. 5,763, 306); claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Tsai in view of Lu et al. (U.S. Patent No. 5,595,928, herein Lu); and claim 16 stands rejected under 35 U.S.C. §103(a) as unpatentable over Tsai in view of the Examiner indicated “Applicant Admitted Prior Art (fig. 1, pages 1-2).”²

Applicants have perfected the priority of the present application, which antedates the primary reference Tsai in the above rejections, by providing an English translation of the Korean counterpart patent application (Korean Application No. 97-23917), which was filed on June 10, 1997, which is prior to the filing date of Tsai. Therefore, Applicants respectfully submit that Tsai is not valid prior art under 35 U.S.C. § 102(e) or § 103(a).

Accordingly, Applicants respectfully request that the above-stated prior art rejections, which all use Tsai as primary reference, be withdrawn.

Further, Applicants respectfully submit that claims 1 and 44 are generic claims with respect to species 1, 2 and 4. Once a generic claim is determined to be allowable, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will be allowable since the additional species will depend thereon or otherwise include the limitations of the generic claim. (*See, e.g.*, MPEP § 806.04(d)). Therefore, because claims 1 and 44 contain allowable subject matter, claims directed to non-elected species 2 and 4 (*i.e.*, claims 4 – 15 and 47-55) should no longer be withdrawn and should also be deemed allowable because they are fully embraced by the generic claims (*see, e.g.*, MPEP § 809.02(c)).

² Applicants respectfully rebut the Examiner's presumption in paragraph 10 of the April 13, 2005 Office Action that “fig. 1, pages 1-2” is Admitted Prior Art. However, in the interest of expediting prosecution and arguments traversing the rejections, Applicants feel it is unnecessary to address this issue at this time.

CONCLUSION

In light of the above, Applicants believe that this application is now in condition for allowance and therefore request favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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